

# REMARKS

Claims 1-20 are currently pending in the present application. Reexamination and reconsideration of the application are respectfully requested. No new matter has been added. Applicant graciously acknowledges the withdrawal of the finality of the last Office Action.

## REJECTION OF CLAIMS 1, 5-12, and 16-20 UNDER 35 U.S.C. 102(b)

Claims 1, 5-12, and 16-20 are rejected under 35 U.S.C. 102(b) for the reasons set forth on page 2 of the Action. Specifically, 1, 5-12, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitagawa et al. (JP 11-183794, hereinafter referred to as "Kitagawa et al." or "the Kitagawa reference").

The rejections under 35 U.S.C. 102(b) are respectfully traversed, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth herein below.

The Federal Circuit has ruled, "Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. . . . In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). [emphasis added.]

Furthermore, the Federal Circuit has held, "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore &

Assocs. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). [emphasis added.]

Regarding claim 1, the Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference, fails to teach or suggest inter alia the following limitation: “a first surface for primarily performing a color correction function, the first surface including a diffraction efficiency improvement mechanism,” as claimed. Regarding claim 12, Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference fails to teach or suggest inter alia the following limitation: “a first optical means for primarily performing a color correction function, the first optical means including a diffraction efficiency improvement means,” as claimed.

The Action refers to refraction surfaces 2, 3 of lens 1 of Kitagawa et al. and diffraction surface 4 as teaching the limitations recited in claims 1, 9, 10, 12 and 20. However, it is respectfully submitted that these surfaces of Kitagawa do not fairly teach or suggest a first surface for primarily performing a color correction function as claimed. For example, there does not appear to be any teaching by Kitagawa et al. of a surface to perform color correction as claimed. Moreover, the cited surfaces, do not appear to fairly teach or suggest, “a second surface for primarily performing the light ray bending function,” as claimed. Consequently, the surfaces of Kitagawa do not fairly teach or suggest the lens as claimed.

Furthermore, the dependent claims also add additional limitations, thereby making the dependent claims a fortiori and independently patentable over the cited references. The

Action refers to aperture 5 and focal plane 6 as teaching the limitations recited in claims 5 and 16. Also, aperture 5 of FIG. 1 of Kitagawa et al. is referenced to teach the limitations recited in claims 6-8, and 17-19. However, dependent claims 6 and 17 recite, “a vignetting reducing mechanism for reducing the shadowing in the corners of an image,” and “means for reducing the shadowing in the corners of an image,” respectively. This limitation does not appear to be taught or suggested by the Kitagawa et al. and T. Kitagawa references. For example, neither reference even mentions the design challenge of reducing shadowing, as does the current application. The Background of the current application states, “Another challenge in single lens design is that the image exhibits vignetting (or shadowing) of the corners of the image. Accordingly, it is desirable for the single lens design to have a mechanism that reduces the amount of vignetting (or shadowing) of the corners of the image.” (see lines 12-15 on page 3 of the Background).

Also, dependent claims 7 and 18 recite, “an aperture positioned at a predetermined distance from the first surface of the lens; wherein the predetermined distance is a value that makes the lens telecentric.” This limitation does not appear to be taught or suggested by the Kitagawa et al. and T. Kitagawa references.

Moreover, dependent claims 8 and 19 recite, “an aperture positioned at a predetermined distance from the first surface of the lens; wherein the predetermined distance causes a chief ray to be generally perpendicular to the focal plane.” This limitation does not appear to be taught or suggested by the Kitagawa et al. and T. Kitagawa references.

After a review of the cited references, there does not appear to be any teaching of the specific claims limitations recited by the dependent claims. In this regard, it is respectfully requested that the next Action specifically point out those portions of the cited reference that teach or suggest the specific recited elements in the claimed invention.

**REJECTION OF CLAIMS 2, 3, 13 & 14 UNDER 35 U.S.C. 103(a)**

Claims 2, 3, 13 & 14 are rejected under 35 U.S.C. 103(a) for the reasons set forth on page 3 of the Action. Specifically, claims 2, 3, 13 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al. (JP 11-183,794) in view of T. Kitagawa et al. (US Pat. No. 6,507,443).

The Action states that Kitagawa et al.'s first lens surface is a convex surface instead of a concave surface as claimed. However, the Action continues that T. Kitagawa discloses a single lens having a first concave aspherical surface and a second convex aspherical surface and that "it would have been obvious at the time the invention was made to those skilled in the art to modify the lens of Kitagawa et al. in light of T. Kitagawa by forming the first surface being concave as taught by T. Kitagawa. In other words, the T. Kitagawa reference is cited for teaching the use of a first concave surface.

The rejections under 35 U.S.C. 103 are respectfully traversed, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow.

The Action on page 2 proposes a combination of Kitagawa's lens with a concave surface from the T. Kitagawa reference. This combination is contested as improper for the

reasons advanced below. However, even if this combination were proper, which is not conceded, the resulting combination would still fail to teach or suggest the claimed invention.

THE PROPOSED COMBINATION IS BASED ON IMPERMISSIBLE USE OF THE CLAIMED INVENTION AS A TEMPLATE TO PIECE TOGETHER THE TEACHINGS OF THE KITAGAWA ET AL. REFERENCE AND THE T. KITAGAWA REFERENCE

It is respectfully submitted that the Kitagawa et al. and T. Kitagawa references are improperly combined. It appears that the Action uses improper hindsight to selectively pick components from the Kitagawa et al. and T. Kitagawa references to arrive at the claimed invention.

The Action suggests that the single lens of Kitagawa et al. be modified with a concave surface from T. Kitagawa as noted previously. It is unclear whether such a modification is enabled by the disclosure of the cited references or whether such a modification or combination is even possible since the surfaces of Kitagawa et al. are design to achieve optical results that are different from those optical properties and results desired the lens design of T. Kitagawa.

Assuming arguendo that a concave surface of T. Kitagawa can be incorporated into the lens design of Kitagawa et al., the Federal Circuit has stated, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) [emphasis added].

The Federal Circuit has further held In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992):

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ... “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art ... would lead that individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). [emphasis added.]

Consequently, it appears that the current patent application has been improperly used as a basis for the motivation to combine or modify the components selected from Kitagawa et al. and the T. Kitagawa references to arrive at the claimed invention. Stated differently, the proposed combination of the cited references appear to be based on hindsight since the cited references do not teach or suggest a motivation to combine the respective elements of each reference in the manner proposed by the Action.

The Federal Circuit has held, “It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)), In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). [emphasis added.]

Furthermore, the Federal Circuit has held, “The combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There

must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.” In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

Accordingly, hindsight reconstruction may not be used to pick a component from Kitagawa et al. and another component from T. Kitagawa to arrive at the invention as claimed. Accordingly, it is respectfully requested that the rejection of claims 6, 7, 15 and 16 under 35 U.S.C. 103(a) be withdrawn.

In view of the foregoing, it is respectfully submitted that the Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference, fails to teach or suggest the single lens as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

It is respectfully submitted that even if the Kitagawa et al. and T. Kitagawa references were properly combined, which is not conceded, the Kitagawa et al. and T. Kitagawa references fail to teach or suggest specific limitation recited by the claims.

It is noted that the dependent claims 2-11 and 13-20 incorporate all the limitations of independent claims 1 and 12, respectively. As advanced previously, each of the independent claims 1 and 12 recites a first surface or first optical means for performing color correction. Regarding claim 1, the Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference, fails to teach or suggest inter alia the following limitation: “a first surface for primarily performing a color correction function,

the first surface including a diffraction efficiency improvement mechanism,” as claimed. Regarding claim 12, Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference fails to teach or suggest inter alia the following limitation: “a first optical means for primarily performing a color correction function, the first optical means including a diffraction efficiency improvement means,” as claimed.

Furthermore, the dependent claims also add additional limitations, thereby making the dependent claims a fortiori and independently patentable over the cited references. For example, claims 3 and 14 recite, “wherein the diffractive portion of the first surface reduces the incident angle of at least one light ray with respect to the first surface, thereby increasing the diffractive efficiency of the lens,” which does not appear to be disclosed by the Kitagawa et al. and T. Kitagawa references.

In view of the foregoing, it is respectfully submitted that the Kitagawa et al. reference, whether alone or in combination with the T. Kitagawa reference, fails to teach or suggest the single lens as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

#### ALLOWABLE SUBJECT MATTER

Applicant graciously acknowledges the allowable subject matter as noted in paragraph 5 of the Action on page 4. However, it is respectfully submitted that the cited references do not fairly disclose the invention as claimed by the broader claims that are pending herein (e.g., the independent claims and the other dependent claims).



Conclusion

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the pending claims are requested, and allowance is earnestly solicited at an early date. The Examiner is invited to telephone the undersigned if the Examiner has any suggestions, thoughts or comments, which might expedite the prosecution of this case.


Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office (fax no.: 571-273-8300) on the date below.

  
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February 23, 2006  
(Date)